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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,178	03/09/2001	William A. Pugh	41017.P001	4745

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EXAMINER	
NGUYEN BA, HOANG VU A	

ART UNIT	PAPER NUMBER
2192	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/803,178	PUGH ET AL.	
	Examiner	Art Unit	
	Hoang-Vu A. Nguyen-Ba	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-16 and 20-33* is/are allowed.

6)☒ Claim(s) *17-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to amendment filed December 02, 2005.

2. Claims 1-33 remain pending.

Response to Arguments

3. Applicant's arguments with respect to the rejection of claims 1-3, 6-11 and 14-16 under 35 U.S.C. § 102(b) as being anticipated by Alderson and of claims 4, 5, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Alderson have been fully considered and are persuasive. Therefore, the rejections of these claims are withdrawn.

4. Applicant's arguments with respect to the rejection of claims 17-19 under 35 U.S.C. § 101 as being directed to non-statutory subject matter have been considered but are not fully responsive and thus not persuasive. Therefore, the rejection of these claims under 35 U.S.C. § 101 is maintained. The **same** (emphasis added) but restated ground of rejection in light of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter (e.g., Annex II), October 2005 is presented hereinafter.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 17-19 are rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

The Supreme Court has ruled that to be statutory, a claimed process must either: (A) result in a physical transformation for which a practical application is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application which produces a useful, tangible, and concrete result.. See Diehr, 450 U.S. at 183-84, 209 USPQ at 6 (quoting Cochran v. Deener, 94 U.S. 780, 787-88 (1876)) ("A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in certain order; but the tools to be used in doing this may be of secondary consequence."). See also Alappat, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting Diehr, 450 U.S. at 192, [209 USPQ at 10]). See also id. at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring)("unpatentability of the principle does not defeat patentability of its practical applications")(citing O'Reilly, 56 U.S. (15 How.) at 114-19).

i. "Practical Application of an Abstract Idea"

While the Supreme Court has ruled that "transformation" is relevant to a section 101 inquiry, the Court has expressly refused to hold that it is the only test for determining patent eligibility. The Federal Circuit has provided further guidance in distinguishing between the judicially-created exceptions to patentable subject matter and eligible subject matter. The focus of the inquiry is whether the claim, considered as a whole, constitutes "a practical application of an abstract idea." State Street, 149 F.3d at 1373, 47 USPQ2d at 1600. Thus, the question of whether a claim encompasses statutory subject matter should not focus on which category of subject matter a claim is directed to (e.g., process or machine), "but rather on the essential characteristics of the subject matter, in particular its practical utility." State Street, 149

F.3d at 1375, 47 USPQ2d at 1602; see also AT&T, 172 F.3d at 1360, 50 USPQ2d at 1453 (focus on section 101 inquiry is "whether the mathematical algorithm was applied in a practical manner"). Accordingly, an "abstract idea" when practically applied to a useful end is eligible for a patent. State Street, 149 F.3d at 1374, 47 USPQ2d at 1601 ("a process, machine, manufacture, or composition of matter employing a law of nature, natural phenomenon, or abstract idea is patentable subject matter even though a law of nature, natural phenomenon, or abstract idea would not, by itself, be entitled to such protection.")(emphasis added); see also Alappat, 33 F.3d at 1543, 31, USPQ2d at 1556-57 (holding that "certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type fo practical application, and thus that subject matter is not, in and of itself, entitled to patent protection.").

ii. "Useful, Concrete and Tangible Result"

In State Street, the Federal Circuit examined some of its prior section 101 cases, observing that the claimed inventions in those cases were each for a "practical application of an abstract idea" because the elements of the invention operated to produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. For example, the court in State Street noted that the claimed invention in Alappat "constituted a practical application of an abstract idea (a mathematical algorithm, formula, or calculation), because it produced 'a useful, concrete and tangible thing – the condition of a patient's heart." Id.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result is "useful, tangible and concrete." The Federal Circuit further ruled that it is of little relevance whether a claim is directed to a

machine or process for the purpose of a § 101 analysis. AT&T, 172 F.3d at 1358, 50 USPQ2d at 1451.

In this instance, it is unclear as to whether the final result of the steps taken recited in claim 17 is useful, concrete and tangible. In claim 1, it is understood that the claimed invention relates to a method for updating a required version of a runtime library, which has a useful, concrete and tangible result. Claim 17, instead is completely silent as to the intended use (i.e., useful), as to the predictability (i.e., concrete), and as to the practicality (i.e., tangible) of the final result.

As a result, Claim 17 and the dependent claims are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter because these claims are not for a practical application that produces a useful, concrete and tangible result.

Claims 18 and 19, which depend from Claim 17, are also rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter for the same reasons.

Allowable Subject Matter

7. Claim 17 is rejected as being directed to nonstatutory subject matter, but would be allowable if rewritten to overcome the 101 rejection.

8. Claims 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if Claim 17 is rewritten to overcome the the 101 rejection.

9. Claims 1-16, 20-33 are allowed.

10. The following is an examiner's statement of the reason for allowance:

Alderson, taken individually or in combination, does neither teach nor suggest the specific limitations that are recited in independent Claims 20, 23, 27 and 30.

Conclusion

11. THIS **ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on the following days of a bi-week: Monday-Thursday (first week) and Tuesday-Friday (second week) from 7:15 to 17:45.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ANTONY NGUYEN-BA
PRIMARY EXAMINER

Art Unit 2192

February 19, 2006